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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,614	06/19/2001	Tomoaki Kageyama	1232-4725	3055
27123	7590	09/22/2004		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER GIBBS, HEATHER D	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/884,614	Applicant(s) KAGEYAMA ET AL.	
	Examiner Heather D Gibbs	Art Unit 2622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-12, 14-28, 30-33 and 35-40 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 13, 29 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

*Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The disclosure is objected to because of the following informalities: Page 6 Lines 24, change "an first" to -a first--.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9,11,14-17, 23-28,30,32,40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamamoto (US 5,721,423).

Regarding claim 1, which is representative of claims 23 and 40, Hamamoto teaches An image reading apparatus comprising: an image reading unit 1 for scanning and reading an image on a predetermined medium (Col 3 Lines 54-68-Col 4 Lines 1-3); transmission means sequentially transmitting image data read by said image reading unit to an external device (Col 4 Lines 31-37); driver 27 displacing relative position between the image and said image reading unit; and a controller for, when image reading operation of said image reading unit suspends, displacing the relative position between the image and said image

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reading unit by said driver to a predetermined position before the suspended position of the image reading operation, and restarting reading operation from the predetermined position (Col 4 Lines 54-67; Col 5 Lines 31-41; Col 7 Lines 5-19).

Regarding claim 2, which is representative of claim 24, Hamamoto discloses further comprising monitoring means for monitoring whether the external device can receive data, wherein said controller suspends operation when said monitoring means reading detects that the external device cannot receive data during execution of reading operation said image reading unit (Col 4 Lines 54-67; Col 5 Lines 7-14).

Considering claim 3, which is representative of claim 25, Hamamoto discloses The apparatus according to claim 2 wherein said monitoring means determines based on a signal from the external device whether the external device receive data (Col 9 Lines 12-25).

Regarding claim 4, which is representative of claim 26, Hamamoto teaches wherein the predetermined position is set in consideration of a distance by which acceleration of said driver ends and a moving speed becomes constant (Col 7 Lines 13-18).

Regarding claim 5, which is representative of claim 27, Hamamoto discloses wherein the predetermined position includes a home position (Col 8 Lines 46-58).

Considering claim 6, which is representative of claim 28, Hamamoto teaches further comprising area designation means for designating a desired image area on the predetermined medium, wherein said image reading unit scans and reads the image area of the predetermined medium designated by said area designation means (Fig 5; Col 5 Lines 19-30).

Regarding claim 9, which is representative of claim 30, Hamamoto teaches further comprising memory for temporarily storing the image data read by said image reading unit,

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wherein the image data read by said image reading unit are sequentially stored in said memory, and said transmission means sequentially transmits the image data stored in said memory to the external device (Col 4 Lines 31-49).

Regarding claim 11, which is representative of claim 32, Hamamoto teaches The apparatus according to claim 9, wherein said memory can successively store image data in an area where image data which have been transmitted to the external device are stored (Col 4 Lines 31-49).

Considering claims 14-15, Hamamoto teaches wherein said driver moves said image reading unit while said image reading unit scans and reads the image on the predetermined medium (Col 3 Lines 63-67; Col 4 Lines 1-3).

Considering claims 16-17, Hamamoto discloses wherein the predetermined medium is illuminated to input optical information to said image reading unit, said image reading unit is fixed, and said driver changes an optical path of the optical information, thereby causing said image reading unit to scan and read the image on the predetermined medium (Fig 2; Col 4 Lines 9-22).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10,12,31,33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamamoto (US 5,721,423) in view of Semite et al (US 6,194,712).

Hamamoto discloses the apparatus and method as discussed above.

Hamamoto does not disclose expressly further comprising available capacity detection means for detecting an available capacity said memory, wherein said controller suspends reading operation said image reading unit when the external device cannot receive data and the available capacity of said memory decreases less than a predetermined capacity.

Semite discloses further comprising available capacity detection means for detecting an available capacity said memory, wherein said controller suspends reading operation said image reading unit when the external device cannot receive data and the available capacity of said memory decreases less than a predetermined capacity (Col 8 Lines 29-44).

Hamamoto & Semite are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Hamamoto and Semite.

The suggestion/motivation for doing so would have been as both systems deal with a scanner and method of controlling same.

Therefore, it would have been obvious to combine Semite with Hamamoto to obtain the invention as specified in claims 10,31.

Considering claim 12, which is representative of claim 33, Semite teaches wherein when reading operation of said image reading unit suspends, said controller waits until the

available capacity of said memory increases, then reading operation said image reading unit restarts from the predetermined position (Col 5 Lines 43-59).

7. Claims 18-19,35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamamoto (US 5,721,423) in view of Bannai (US 6,587,226).

Regarding claims 18-19, which are representative of claims 35-36, Hamamoto discloses the apparatus as discussed above.

Hamamoto does not disclose expressly The apparatus according to claim 1 further comprising notification means for notifying the external device of a suspension notification when reading operation of said image reading unit suspends and The apparatus according to claim 18, wherein said notification means notifies the external device of the suspension notification and a discard instruction of discarding image data which have been transmitted by image reading operation.

Bannai discloses further comprising notification means for notifying the external device of a suspension notification when reading operation of said image reading unit suspends and The apparatus according to claim 18, wherein said notification means notifies the external device of the suspension notification and a discard instruction of discarding image data which have been transmitted by image reading operation (Col 10 Lines 4-14).

Hamamoto & Bannai are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Hamamoto with Bannai.

The suggestion/motivation for doing so would have been as both systems deal with a data processing involving an external terminal.

Therefore, it would have been obvious to combine Bannai with Hamamoto to obtain the invention as specified in claims 18-19.

8. Claim 20,37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamamoto in view of Okamoto (US 4,958,298).

Considering claim 20, which is representative of claim 37, Hamamoto discloses the apparatus as discussed above.

Hamamoto does not disclose expressly The apparatus according to claim 1 further comprising notification means for notifying the external device of a restart enable notification when reading operation of said image reading unit can restart.

Okamoto discloses The apparatus according to claim 1 further comprising notification means for notifying the external device of a restart enable notification when reading operation of said image reading unit can restart (Col 2 Lines 3-26).

Hamamoto & Okamoto are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include notification means in an image reading unit for restart purposes.

The suggestion/motivation for doing so would have been to clear unwanted data stored in memory, as taught by Okamoto.

Therefore, it would have been obvious to combine Okamoto with Hamamoto to obtain the invention as specified in claim 20.

9. Claims 21-22,38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamamoto in view of Ito (US 6,674,553).

Hamamoto discloses the apparatus as discussed above.



Hamamoto does not disclose expressly wherein the predetermined medium includes a microfilm and further comprises a display on which an image on the microfilm is projected, and said image reading unit scans and reads the image projected on said display.

Ito discloses wherein the predetermined medium includes a microfilm and further comprises a display on which an image on the microfilm is projected, and said image reading unit scans and reads the image projected on said display (Col 10 Lines 52-61; Ref 600; Col 10 Lines 62-67; Ref 180).

Hamamoto & Ito are combinable because they are from the same scope of nature.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a microfilm that reads a projected image on a display.

The suggestion/motivation for doing so would have been for a user to perform various functions without going between the image reading operations and a personal computer, as taught by Ito.

Therefore, it would have been obvious to combine Ito with Hamamoto to obtain the invention as specified in claims 21-22,38-39.

#### ***Allowable Subject Matter***

10. Claims 7-8,13,29,34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

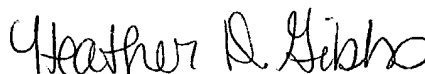
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*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Heather D Gibbs  
Examiner  
Art Unit 2622

hdg



EDWARD COLES  
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